

AMENDMENT UNDER 37 C.F.R. § 1.111  
Application No.: 10/501,213

Attorney Docket No.: Q82529

**AMENDMENTS TO THE DRAWINGS**

FIGS. 36-38 have been labeled as --Prior Art--.

Attachment: Two (2) Replacement Sheets

**REMARKS**

Claims 9-13 and 17-27 are all the claims pending in the application. By this amendment, Applicant has added new dependent claims 26 and 27.

Claims 9 and 13 are independent claims.

**Non-Finality of Office Action**

Applicant thanks the Examiner for confirming that the Office Action mailed February 26, 2008, is *Non-Final* during the telephone interview with Applicant's representative, Brian W. Hannon, on March 13, 2008.<sup>1</sup> During this interview, the Examiner confirmed that the Office Action mailed February 26, 2008 is Non-Final, as indicated in the Summary of the Office Action page, even though the Office Action also indicates that the action is Final on page 5.

**Drawings**

The Examiner has objected to FIGS. 36-38, alleging that these drawings should be designed by a legend such as --Prior Art--. In response, Applicant has labeled these drawings in the manner requested by the Examiner.

**Claim Rejection Under 35 U.S.C. § 102**

Claims 9 and 22 are rejected under 35 U.S.C. § 102(b) as being anticipated by DE 43 34 195 (DE '195).

Claims 9 and 22 are also rejected under 35 U.S.C. § 102(a) as being anticipated by Applicant's Admitted Prior Art (AAPA).

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<sup>1</sup> The PTO's PAIR website also indicates that this Office Action is *Non-Final*.

Claim 9

With respect to independent claim 9, Applicant respectfully traverses the rejection at least because neither DE '195 nor the AAPA discloses all of the claim's recitations. For example, neither DE '195 nor the AAPA discloses the claimed rolling bearing in which a groove of desired depth is provided in a part of the raceway groove for one of said bearing rings and in which the rolling elements are rotatable using the groove provided in the part of the raceway groove.

Because a groove is provided in the rolling bearing of claim 9, when the bearing rings are assembled, the rolling element can be rotated without damaging the raceway surface.<sup>2</sup>

However, as shown in for example FIG. 1 of DE '195, neither of the bearing rings 2 or 3 includes the recited groove.

Moreover, the Examiner asserts that the outer and inner raceways 30, 40 shown in AAPA FIG. 37 of the original specification correspond to the recited "pair of raceway grooves." However, as is apparent from FIG. 37, the AAPA does not disclose that a groove provided in either the outer raceway 30 or the inner raceways 40.

Thus, Applicant respectfully requests the Examiner to withdraw this rejection of independent claim 9.

Claim 22

Applicant respectfully requests the Examiner to withdraw this rejection of dependent claim 22 at least because of its dependency from claim 9.

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<sup>2</sup> See, for example, original specification at page 16, lines 5-20.

**Claim Rejections Under 35 U.S.C. § 103**

**DE ‘195 in view of DE 100 27 105**

Claims 10-12, 20 and 23 are rejected under 35 U.S.C. § 103(a) as being unpatentable over DE ‘195 in view of DE 100 27 105 (DE ‘105).

Applicant respectfully requests the Examiner to withdraw this rejection of claims 10-12, 20, and 23 at least because of their dependency from claim 1 and because DE ‘105, which the Examiner asserts as showing a retainer having inclined axial pocket faces, does not cure the deficiencies in DE ‘195 discussed above.

**DE ‘195 in view of WO ‘167**

Claims 13, 21, 24 and 25 are rejected under 35 U.S.C. § 103(a) as being unpatentable over DE ‘195 in view of newly cited WO 90/13167 (WO ‘167).

**Claim 13**

With respect to independent claim 13, Applicant respectfully traverses the rejection at least because the claimed rolling bearing would not have been obvious in view of DE ‘195 and WO ‘167. For example, the claimed rolling bearing, in which a groove of desired depth is provided in a part of the raceway groove for one of said bearing rings and in which the rolling elements are rotatable using the groove provided in the part of the raceway groove, would not have been obvious in view of DE ‘195 and WO ‘167.

As discussed above, with respect to claim 9, DE ‘195 does not disclose these features.

Moreover, DE ‘105, which the Examiner asserts as showing a retainer having inclined axial pocket faces, does not cure this deficiencies in DE ‘195.

Claims 21, 24, and 25

Applicant respectfully requests the Examiner to withdraw this rejection of claims 21, 24, and 25 at least because of their dependency from claim 13.

**DE ‘195 in view of WO ‘167 and DE ‘105**

Claims 17-19 are rejected under 35 U.S.C. § 103(a) as being unpatentable over DE ‘195 in view of WO ‘167, and further in view of DE ‘105.

Applicant respectfully requests the Examiner to withdraw this rejection of claims 17-19 at least because of their dependency from claim 13, and because DE ‘105 does not cure the deficiencies in the combination of DE ‘195 and WO ‘167 discussed above.

**New Claims**

Finally, Applicant has added new dependent claims 26 and 27 in order to provide additional claimed subject matter. Applicant respectfully submits that these claims are patentable at least because of their dependency from independent claims 9 and 13.

Moreover, According to new claims 26 and 27, when the rolling bearing is assembled and *a preload is applied*, if rolling element is rotated without providing the groove provided in the part of the raceway groove, an edge between flat side surfaces of the rolling element and the raceway surface of the rolling element scratches the raceway surface of the raceway rings and damages it.<sup>3</sup> Therefore, when the rolling bearing is assembled with application of a preload, the groove provided in the raceway groove provides an additional advantageous function.

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<sup>3</sup> See original specification at page

**Conclusion**

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

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CUSTOMER NUMBER

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